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Paper No. 13

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DEC 05 2007

In re Application of  
Carmichael, et al.  
Application No. 09/645,216  
Filed: August 24, 2000  
Attorney Docket No. 21100-005001

**OFFICE OF PETITIONS**

**DECISION ON PETITION**

This is a decision on the petition under the unavoidable provisions of 37 CFR 1.137(a), filed July 13, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is not a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to reply in a timely manner to the Restriction Requirement, mailed August 15, 2003, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on September 16, 2003.

The petition fee of \$250.00 will be charged to deposit account no. 06-1050.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). The instant petition lacks item (3).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.C.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Petitioner argues that the delay in responding to the August 15, 2003 Restriction Requirement was unavoidable because Lyon and Lyon, LLP, the firm representing assignee, (International Apparel Group LLC), dissolved and did not return complete application files to assignee and that assignee's choice of another law firm was unable or unwilling to represent them. Petitioner argues that assignee used reasonable care over many years and continually attempted to obtain a copy of the application file from Lyon and Lyon and obtain new attorneys to handle the prosecution of this application.

Petitioner's arguments have been considered carefully. However, petitioner has not established to the satisfaction of the Director that the delay in responding to the August 15, 2003 Restriction Requirement was unavoidable.

A review of the application file reveals that a Revocation of Power of Attorney or Authorization of Agent was filed on August 28, 2002. The Office was directed to mail all correspondence to:

International Apparel Group LLC  
11 Columbia Street, Suite B  
Aliso Viejo, CA 92656

The August 15, 2003 Restriction Requirement was mailed to this address.

The petition states in May 2003 (several months before the Office action in question was mailed), International Apparel Group, LLC moved from the Aliso Viejo address to 114 Pacifica

Ave., Suite 150, Irvine CA. The petition states that International Apparel Group, LLC eventually changed their address with the Office, however they were unclear this was even necessary, since Lyon and Lyon still had the application files.

Petitioner is informed that Lyon and Lyon, LLP were not responsible attorneys of record when the August 15, 2003 Restriction Requirement was mailed. As stated above, International Apparel Group, LLC revoked Lyon and Lyon, LLP's power of attorney on August 28, 2002. The Office mailed the August 15, 2003 Restriction Requirement to an out-of-date address for International Apparel Group, LLC due to International Apparel Group, LLC's inattention to patent matters. The physical location of the application file is largely irrelevant because the August 15, 2003 was mailed to International Apparel Group, LLC at an out-of-date address.

A delay caused by the failure on the part of petitioner to provide the U.S. Patent and Trademark Office with a current correspondence address does not constitute an unavoidable delay. *See Ray v. Lehman*, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995). Petitioner is informed that a request that the U.S. Postal Service forward all mail is not the same as changing the correspondence address with the U.S. Patent and Trademark Office.

Petitioner is encouraged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an “unintentionally” abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was “unavoidable.” This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An “unintentional” petition under 37 CFR 1.137(b) must be accompanied by the \$770.00 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION  
Commissioner for Patents  
P. O. Box 1450  
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By hand: U. S. Patent and Trademark Office  
Customer Service Window, Mail Stop Petitions  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

By facsimile: **(571) 273-8300**  
Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.

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